

REMARKS

Claim Objections

The Examiner objected to the Claims below because of the following informalities and requested appropriate corrections:

Claims 7 and 8, there is lack antecedent basic for “said array of light emitting diodes”. There is no “array of light emitting diodes” being recited in claim 6 or 1.

Claims 19 and 20, there is lack antecedent basic for “said array of light emitting diodes”. There is no “array of light emitting diodes” being recited in claim 18 or 14.

Applicant has amended claims 7, 8, 19 and 20 to correct the noted deficiencies.

Withdrawal of this rejection is respectfully requested.


Rejection under 35 U.S.C. 102

In the office action, the Examiner stated that Claims 14, 16 - 19 were rejected under 35 U.S.C. 102(b) as being anticipated by Chien [US 5,485,358]. The Examiner stated that regarding claim 14, Chien discloses a hat with a crown and a bill, and LED5 [04] (figure 1, column 2 lines 20_23). The Examiner also stated that regarding claim 16, Chien discloses an array of LED5 [04] (figure 1). The Examiner also stated that regarding claim 17, Chien discloses two arrays of LED5 [04] at a single trap [02 and 02Æ] (figure 1). In addition, the Examiner stated that regarding claim 18, Chien discloses a plurality of LEDs [04] (figure 1). Finally, the Examiner stated that regarding claim 19, Chien discloses a plurality of LEDs [04] to emit a single color spectrum (figure 1, column 2 lines 29-31).

Applicant amended independent claim 14 to require that the light emitting diode lighting apparatus be contained within a single housing that is permanently attached to front visor and crown of the hat.

Applicant contends it is axiomatic that prima facie anticipation requires that the reference, under any of the subsections of Section 102, teach the subject matter. The reference must generally place the needed subject matter supporting the anticipation rejection in the public domain before the date of invention. Therefore, this element of anticipation contains two main requirements for a reference to support an anticipation rejection: (1) the reference must disclose the claimed invention, and (2) it must be available to the public. Furthermore, the description must enable a person with ordinary skill in the art to not only comprehend the invention but also to make it.

Applicant asserts that Chien specifically discloses and claims an array of lights permanently mounted at the rear of the cap (See Figs. 1, 2, 7). Furthermore, Chien discloses that the invention functions as an integral part of the adjusting strap part located on the rear of the cap (Column 1, lines 8-9, 21-24). Chien makes further disclosure that the LED lights function as the protruding parts of the adjusting strap (Fig. 3, Col. 2, lines 19-20). Chien also discloses a lighting system that is mounted in different individual parts in the cap (see Fig. 2, Col. 2, lines 27-36) that required connection with a channeled wiring harness (Fig. 2, Col. 2, lines 24-27).



Applicant's disclosed and claimed invention is an LED lighting apparatus with its switch, power source, and circuitry all contained in a single housing mounted on the front or crown of the cap. The single housing design does not required to it to function as part of or be located on the adjusting strap of the cap. Furthermore, the single housing design does not require the channeled electrical harness of Chien. The locations and design of the present invention provides a further advantage over the Chien apparatus. Applicant asserts that as disclosed, the Chien apparatus is limited in the number of LED that can be mounted on the cap whereas the crown area (both in width and height) of the cap where the Applicant's invention is mounted provides significantly more flexibility in providing an series of LED on an array for lighting purposes.

The Applicant's invention is also distinguished over Chien because the LED lights are focuses in a forward direction to provide the wearer with increased visibility in challenging lighting conditions (e.g. aircraft cockpit at night, performing operations in reduced visibility conditions). The LED lights of Chien would not provide light focused in the forward direction but rather would function to increase the visibility of the cap to other viewers.

Claims 16-19 that are dependent on independent claim 14, are patentable in light of the Applicant's assertion that claim 14 is patentably distinct.

Applicant respectfully asserts that the Examiner has not demonstrated anticipation in accordance with the law. Furthermore, it is submitted that Chien fails to teach a combination of elements necessary to anticipate the Applicant's invention. Thus, Applicants respectfully submit that the amended claim 14, 16-19 are patentably distinct over Chien.

Rejection under 35 U.S.C. 103(a)

The Examiner stated that Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chien as applied to claim 16 above, and further in view of Lebens et al. [US 6,095,661].

The Examiner stated that regarding claim 20, Chien discloses a plurality of LEDs [04], but Chien does not disclose the LEDs emanating more than one color spectrum.

The Examiner noted that Lebens et al. teach the use of a plurality of LEDs [1 50], which emits more than one color spectrum for purpose of high intensity and color effect (figure 1, column 4, lines 23-35, column 5 lines 33-40 and column 7 lines 17-23).

The Examiner concluded that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the plurality LEDs of Chien with the plurality LEDs of Lebens et al. to emit more than one color spectrum in order to provide an advantage of visual effect.

Applicant would like to first incorporate the arguments made in reference to the lack of anticipation in light of Chien as discussed above.

The Applicant argues respectfully that the Examiner has not met the burden of establishing a prima facie case of obviousness in accordance with current patent law.

There are several elements necessary to correctly conclude that a claim of obviousness has been established. One of the primary elements of establishing a prima facie case of obviousness is that the references generally place the needed subject matter supporting the obviousness rejection in the public domain before the date of invention (*In re Zenitz*, 333 F.2d 924, 142 USPQ 158, (C.C.P.A. 1964). In this regard, the Federal Circuit has stated that “the test for obviousness is not whether the features of one reference may be bodily incorporated into another reference . . . Rather; we look to see whether combined *teachings* render the claimed subject matter obvious” (*In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added)(citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-550 (C.C.P.A. 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (C.C.P.A. 1964).

Another primary element of establishing a prima facie case of obviousness is that the references require some reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined or modified the references. With respect to the required element, the Federal Circuit has stated that “obviousness cannot be

established by combining the teachings or the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”

With respect to this required element, the Federal Circuit has stated that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” (See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). See also *Diversitech Corp. v. Centure Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ 2d 1315, 1318 (Fed. Cir. 1988); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 311 (Fed. Cir. 1983):

In concluding that obviousness was established by the teachings in various pairs of references, the district court lost sight of the principle that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention before the court would have been obvious. (Citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (C.C.P.A. 1961)), *cert. denied*, 469 U.S. 851 (1984).

The Patent Office applies this same standard as explained by the Board, “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper...” Absent such reasons or incentives, the teachings of the references are not combinable. (*Ex parte Skinner*, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1987).

Still another element of prima facie obviousness requires that the resulting combination or modification appear to show or suggest the claimed invention.

The Applicant asserts that the present invention is not obvious in light of Chien in view of Lebens.

Applicant asserts that Chien specifically discloses and claims an array of lights permanently mounted at the rear of the cap (See Figs. 1, 2,7). There is no teaching or disclosure to mount the LED array on the visor or crown of the cap. This is supported further by the Chien disclosure where the invention functions as an integral part of the adjusting strap part located on the rear of the cap (Column 1, lines 8-9, 21-24). Chien makes further disclosure that the LED lights function as the protruding parts of the adjusting strap (Fig. 3, Col. 2, lines 19-20). Chien also discloses a lighting system that is mounted in different individual parts in the cap (see Fig. 2, Col. 2, lines 27-36) that required connection with a channeled wiring harness (Fig. 2, Col. 2, lines 24-27).

Lebens et al. discloses a flashlight with LED and appropriate circuitry. There is no teaching, suggesting, or disclosure to make the flashlight a part of cap. The flashlight, as disclosed in Lebens et al. would not be amenable for mounting on a cap.

Thus, Applicants respectfully submit that the dependent claim 20 is patentably distinct and are fully distinguishable over Chien and Lebens et al. Withdrawal of this 103(a) rejection is therefore requested.

Rejection under 35 U.S.C. 103(a)

The Examiner rejected Claims 23 - 25 under 35 U.S.C. 103(a) as being unpatentable over Kirk [US 6,250,769] and further in view of Lebens et al. [US 6,095,661].

The Examiner stated that regarding claims 23-25, Kirk discloses a cap [1] with a cove portion [2] and a visor [4], a flash light body [8], a battery flashlight and light source [6] and a slide switch [9Æ] (figure 1, column 1 lines 60-67, column 2 lines 1-22). However, Kirk does not clearly disclose one or more LEDs.

Lebens et al. teach the use of a plurality of LEDs [150] in a flashlight for purpose of high intensity and color effect (figure 1, column 4 lines 23_35, column 5 lines 33_40 and column 7 lines 17-23).

The Examiner contends that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the plurality LEDs of Lebens et al. to emit more than one color spectrum in order to provide an advantage of visual effect.

Applicant has cancelled claims 23-25 and therefore the matter is now moot.

Rejection under 35 U.S.C. 103(a)

The Examiner rejected Claims 1 - 25 under 35 U.S.C. 103(a) as being obvious over Lary [US 5,567,038] in view of Chien [US 5,485,358].

The examiner explained the following: The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP §706.02(l)(1) and §706.02(l)(2).

The Examiner stated that regarding claims 1-25, Lary discloses a hat [13] with a crown [14] and a bill [15], a lens cover [12] and a housing [19] containing a battery [26], a halide light [32] and a switch [25]. Lary discloses a series of attachment including a series of hooks [18], a series of loops [16] and segments of loops [21] (figures 1-6, column 2, lines 44-67, column 3, lines 1-62). Lary does not disclose the lighting emitting diode lighting device.

The Examiner contends that Chien teaches the use of array of LEDs in a headwear for purpose of increase lifetime of the light sources (title, figures 1-8, column I lines 35-40, and column 2 lines 39-42).

The Examiner states that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the array of LEDs of Chien to replace the halide light in order to provide a longer lifetime bulb.

The Examiner corrected noted that the applied reference has a common inventor with the instant application.

The Examiner correctly described the law that if based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome as defined above.

Applicant would like to first incorporate the arguments made in reference to the lack of anticipation in light of Chien as discussed above.

Applicant responds, in this case, both the subject matter of the prior art and the claimed matter of the present invention are subject to an obligation of assignment to the same person (organization). At the time the invention was made, Banning Lary had an obligation of assignment of the subject matter and claimed matter of the prior art Halide patent to MacBrud Corporation organized under the state laws of Florida. MacBrud Corporation markets products both domestically and internationally. Furthermore, at the time the LED invention was made, both Banning Lary and his son Todd Lary had an obligation of assignment of the claimed matter to also MacBrud Corporation. The Applicant filed assignment papers to MacBrud Corporation in October 2002 for 1) the subject matter prior art patent, and 2) the claimed invention filed currently with the PTO.

The Applicant asserts that the Lary prior art reference is now declassified and that Applicant asserts that Chien specifically discloses and claims an array of lights permanently mounted at the rear of the cap (See Figs. 1, 2,7). There in no teaching or disclosure to mount the LED array on the visor or crown of the cap. This is supported further by the Chien disclosure where the invention functions as an integral part of the adjusting strap part located on the read of the cap (Column 1, lines 8-9, 21-24). Chien make further disclosure that the LED lights function as the protruding parts of the adjusting strap (Fig. 3, Col. 2, lines 19-20. Chien also discloses a lighting system that is

mounted in different individual parts in the cap (see Fig. 2, Col. 2, lines 27-36) that required connection with a channeled wiring harness (Fig. 2, Col. Fig. 2, lines 24-27).

Reconsideration is requested of the rejection of independent claims 1-25 as being patentable under 35 U.S.C. §103 in view of the disclosures of Chien alone. Chien fails to suggest those features of Applicants' invention, as discussed above. Appropriate withdrawal of this 103(a) rejection is therefore requested.

Futhermore, the Applicant argues respectfully that the Examiner has not met the burden of establishing a prima facie case of obviousness in accordance with current patent law.

The Applicant contends that there are several elements necessary to correctly conclude that a claim of obviousness has been established. One of the primary elements of establishing a prima facie case of obviousness it that the references generally place the needed subject matter supporting the obviousness rejection in the public domain before the date of invention (In re Zenitz, 333 F.2d 924, 142 USPQ 158, (C.C.P.A. 1964). In this regard, the Federal Circuit has stated that “the test for obviousness is not whether the features of one reference may be bodily incorporated into another reference . . . Rather; we look to see whether combined *teachings* render the claimed subject matter obvious” (In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added)(citing In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549-550 (C.C.P.A. 1969); In re Mapelsden, 329

F.2d 321, 322, 141 USPQ 30, 32 (C.C.P.A. 1964).

Another primary element of establishing a prima facie case of obviousness is that the references require some reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined or modified the references. With respect to the required element, the Federal Circuit has stated that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”

With respect to this required element, the Federal Circuit has stated that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” (See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). See also *Diversitech Corp. v. Centure Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ 2d 1315, 1318 (Fed. Cir. 1988); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 311 (Fed. Cir. 1983):

In concluding that obviousness was established by the teachings in various pairs of references, the district court lost sight of the principle that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention before the court would have been obvious. (Citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (C.C.P.A. 1961)), *cert. denied*, 469 U.S. 851 (1984).

The Patent Office applies this same standard as explained by the Board, “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper...” Absent such reasons or incentives, the teachings of the references are not combinable. (Ex parte Skinner, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1987).

Still another element of prima facie obviousness requires that the resulting combination or modification appear to show or suggest the claimed invention.

Applicant asserts that Chien specifically discloses and claims an array of lights permanently mounted at the rear of the cap (See Figs. 1, 2,7). There is no teaching or disclosure to mount the LED array on the visor or crown of the cap. This is supported further by the Chien disclosure where the invention functions as an integral part of the adjusting strap part located on the rear of the cap (Column 1, lines 8-9, 21-24). Chien makes further disclosure that the LED lights function as the protruding parts of the adjusting strap (Fig. 3, Col. 2, lines 19-20). Chien also discloses a lighting system that is mounted in different individual parts in the cap (see Fig. 2, Col. 2, lines 27-36) that required connection with a channeled wiring harness (Fig. 2, Col. 2, lines 24-27). There is absolutely no disclosure, teaching, or suggestion that Chien mount the LEDs in a single housing mounted on the crown/visor and facing in the forward direction.

The Examiner also noted that Lary 5,738,431 discloses a hat [13] with a crown [14]

and a bill [15], a lens cover [12] and a housing [19] containing a battery [26], a halide light [32] and a switch [25]. The Examiner also noted that Lary '431 discloses a series of attachment including a series of hooks [18], a series of loops [16] and segments of loops [21] (figures 1-6, column 2, lines 44-67, column 3, lines 1-62). The Examiner also correctly noted that Lary '431 does not disclose the lighting emitting diode lighting device. Furthermore, the Applicant asserts that this is no disclosure, teaching, or suggestion to use LEDs in the '431 patent.

The Applicant asserts that the present invention is not obvious in light of Lary [US 5,567,038] in view of Chien [US 5,485,358].

Thus, Applicants respectfully submit that the dependent claims 1-25 are patentably distinct and are fully distinguishable over Lary and Chien. Withdrawal of this 103(a) rejection is therefore requested.

Double Patenting

The Examiner stated that this application is subject to nonstatutory double patenting rejection that is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937,

214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

The Examiner stated that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Also stated is that effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The Examiner stated that Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,567,038 and over claims 1-11 of U.S. Patent No. 5,911,494 in view of Chien [US 5,485,358]. The claims of US Patent No. 5,567,038 and No. 5,911,494 do not disclose the plurality of LEDs. Chien teaches the use of array of LEDs in a headwear for purpose of increase lifetime of the light sources (title, figures 1-8, column I lines 35-40 and column 2 lines 39-42).

The Examiner concluded that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the array of LEDs of Chien to replace the halide light in order to provide a longer lifetime bulb.

The Applicant has attached in Exhibit I a terminal disclaimer for the commonly owned applications.

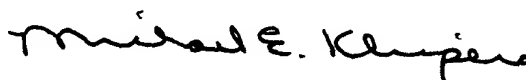
Withdrawal of this judicially created obviousness-type double patenting rejection is respectfully requested.

CONCLUSION

In conclusion, Applicants respectfully assert that claims 1-22 are patentable for the reasons set forth above and that the application is now in condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at (619) 980-8680 for any reason that would advance the instant application to issue.

Dated this twentieth day of February, 2003.

Respectfully submitted,

A handwritten signature in black ink that reads "Michael E. Klicpera". The signature is written in a cursive, flowing style.

**Michael E. Klicpera
Attorney for Applicant
Registration No. 38,044**